



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,805	03/28/2006	Youhei Sakamoto	278542005000	9375
25225 7590 12/10/2009 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
EXAMINER				
SHEDRICK, CHARLES TERRELL				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
12/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/573,805

**Applicant(s)**

SAKAMOTO ET AL.

**Examiner**

CHARLES SHEDRICK

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 9 indicate a “non-telephone function stop unit operable to cause...” The Examiner respectfully notes that original disclosure appears to be absent of a non telephone function stop unit. The Examiner is unable to find any units within the original disclosure explicitly labeled non-telephone function stop unit. Therefore, based on the context of the operation of the non -telephone stop unit (i.e., it appears that the above noted unit parallels the function of the auto-power-off unit) the Examiner shall interpret the unit based on its operation.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2617

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. US Patent No.: 6,947,728 B2, hereinafter, "Tagawa" in view of Nariai et al, US Patent Pub. No.: 2002/0082059 A1, hereinafter, "Nariai".

Consider **claims 1 and 11**, Tagawa teaches a method and a mobile phone having a non-telephone function, which is a different function from a telephone function, in addition to the telephone function, comprising: a non-telephone unit operable to execute the non-telephone function (e.g., **music reproduction function**)(see at least abstract and at least col. 2 lines 7-10); a timer operable to count time (e.g., **the control unit counts the time as noted in at least col. 16 lines 19-25**); a non telephone function stop unit operable to cause the timer to operate

during execution of the non-telephone function (e.g., **the fade out, fade in time, response time, music reproduction time**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and **figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1**), and automatically stop the execution of the non-telephone function(i.e., **stop reproducing of music on receiving a call as noted in at least col. 3 lines 18-25**)( see also at least col. 3 line 63-col. 4 line 8, and **figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1**); a telephone unit operable to execute the telephone function(e.g., **incoming call as noted in at least the abstract**); and a reset unit operable, if the timer is being operated in response to the execution of the non-telephone function to reset the timer to an initial state each time a predetermined operation relating to the telephone function is executed(**carefully note the interpretation of “an initial state and reset**)(e.g., **an initial state of counting the time elapsed from when a ring tone starts. Also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to where the user was originally listening prior to an incoming call function**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and **figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1**).

However, Tagawa does not specifically teach a unit that automatically stop the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period.

In analogous art, Nariai teaches a unit that automatically stops the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period (i.e., **the controller performs control so that the reproduction of the data is stopped after a lapse of**

**an arbitrary preset time from the start of the reproduction of data(musical data etc.) as noted in at least paragraph 0015).**

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include a unit that automatically stop the execution of the non-telephone function when the timer indicates an elapse of a predetermined time period for the purpose of improving the ease of use during charging and increase the speech time as taught by Nariai (**paragraph 0002**).

Consider **claim 2 and as applied to claim 1**, Tagawa as modified by Nariai teaches wherein the reset unit resets the timer to the initial state at end of a telephone call(**i.e., the reset unit must run the original count routine**)(e.g., **an initial state of counting the time elapsed from when a ring tone starts. see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1**).

Consider **claim 3 and as applied to claim 2**, Tagawa as modified by Nariai teaches wherein the telephone unit stops executing the telephone function when receiving a disconnect signal via a telephone line at the end of the telephone call (**see cited sections and explanations below with regard to resuming music listening function**), and the reset unit resets the timer to the initial state when the execution of the telephone function is stopped by receiving the disconnect signal(e.g., **an initial state of counting the time elapsed from when a ring tone starts and as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to where the user was originally listening prior to an incoming call function**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B

**with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1).**

Consider **claim 5 and as applied to claim 1**, Tagawa as modified by Nariai teaches wherein the reset unit further resets the timer to the initial state each time execution of a certain operation relating to the non-telephone unit is started(e.g., **an initial state of counting the time elapsed from when a ring tone starts and as also noted in the above cited sections the unit can reset the timer to the initial state of the track or reset to where the user was originally listening prior to an incoming call function**)( see at least col. 3 lines 18-25, col. 3 line 63-col. 4 line 8, and figures 13A- 14B with respect to timing explanations, see also col. 13 lines 20-51, col. 16 lines 19-25, and claim 1).

Consider **claim 6 and as applied to claim 1**, Tagawa as modified by Nariai teaches the claimed invention further comprising: an application unit operable to execute an application different from the non-telephone function and the telephone function (i.e., as noted in the **Applicants specs a change of setting or other general functions**)(e.g., see **key inputs and buttons for various functions**)( col. 8 lines 17-60), wherein the reset unit further resets the timer to the initial state each time execution of a certain operation relating to the application unit is started(i.e., **set again to an initial state of tracking predetermined time periods**) (e.g., the **timer is reset based on input functions and settings noted in col. 8 lines 17-60**).

Consider **claim 7 and as applied to claim 1**, Tagawa as modified by Nariai teaches wherein the reset unit resets the timer to the initial state each time a particular key is pressed by a user(i.e., **set again to an initial state of tracking predetermined time periods**) (e.g., the **stop key resets a listening tracking and the timing thereof**)( col. 8 lines 17-60).

Consider **claim 8 and as applied to claim 1**, Tagawa teaches the claimed invention except further comprising: an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein the reset unit refrains from resetting the timer to the initial state when the alarm setting has been made.

However, in analogous art, Nariai teaches an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user (**e.g., alarm is generated before the reproduction of data is stopped as noted in at least paragraph 0022**), wherein the reset unit refrains from resetting the timer to the initial state when the alarm setting has been made (i.e., the clock does not reset until charge function begins)(**e.g., see figures 4 and 13**).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein the reset unit refrains from resetting the timer to the initial state when the alarm setting has been made for the purpose of improving the ease of use during charging and increase the speech time as taught by Nariai (**paragraph 0002**).

Consider **claim 9 and as applied to claim 1**, Tagawa teaches the claimed invention except further comprising: an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein the non telephone stop unit automatically stops the execution the function in a case when (i) an auto-power-off setting has been made by the user , **or** (ii) the alarm setting has been made by the user although the auto-power-off setting has not been made.

However, In analogous art Nariai teaches an alarm unit operable to execute an alarm



function in a case when an alarm setting has been made by a user (e.g. **204 figure 2**), wherein a unit automatically stops the execution a function in a case when (i) an auto-power-off setting has been made by the user (e.g., see **manual settings noted in at least figures 7, 8 and 9 and user configuration noted in at least paragraph 0066**), or (ii) the alarm setting has been made by the user although the auto-power-off setting has not been made.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa to include an alarm unit operable to execute an alarm function in a case when an alarm setting has been made by a user, wherein the non telephone stop unit automatically stops the execution the function in a case when (i) an auto-power-off setting has been made by the user , **or** (ii) the alarm setting has been made by the user although the auto-power-off setting has not been made for the purpose of improving the ease of use during charging and increase the speech time as taught by Nariai (**paragraph 0002**).

Consider **claim 10 and as applied to claim 1**, Tagawa as modified by Nariai teaches wherein the non-telephone function is any of a digital camera function, an Internet connecting function, a music play function, a radio function, and a TV function (e.g., see **music production as noted in at least abstract and above noted citations**).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. US Patent No.: 6,947,728 B2, hereinafter, "Tagawa" in view of Nariai et al, US Patent Pub. No.: 2002/0082059 A1, hereinafter, "Nariai" and further in view of Yoshinaga, US Patent No.: 7,096,045 B2.

Consider **claim 4 and as applied to claim 1**, Tagawa as modified by Nariai teaches the claimed invention except wherein the reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed.

However, in analogous art, Yoshinaga teaches wherein a reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed (**col. 7 lines 35-55**)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Tagawa as modified by Nariai to include a reset unit resets the timer to the initial state when the mobile phone is flipped/slid open or closed for the purpose of reducing power consumption as taught by Yoshinaga (**col. 2 lines 15-24**).

#### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES SHEDRICK whose telephone number is (571)272-8621. The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles Shedrick/  
Examiner, Art Unit 2617

/LESTER KINCAID/  
Supervisory Patent Examiner, Art Unit 2617